

## Irish, UK and European Trade Marks

In the UK and Ireland, trade mark rights derive from both use and registration. Registration of a trade mark gives the owner a statutory monopoly. If a competitor uses the same or a similar Mark on the same or similar goods, the owner of a registered trade mark can sue for infringement of their Registration.

### What Trade Marks are Registrable?

A registered trade mark may consist of any sign which can be represented graphically and which is capable of distinguishing the goods or services of one trader from those of other traders.

Such signs may include words, names, colours, slogans, designs, logos, letters, the shape of goods or their packaging and possibly even sounds, smells and gestures. Well known geographical names can be difficult to register unless it can be established that the Mark has become distinctive through use.

It is not possible to register words which directly describe the character or quality of the goods or words which other traders may legitimately require to use in the conduct of their business.

### Avoiding Conflict with Prior Trade Marks

When devising and adopting a new trade mark, it is advisable to carry out a search of the trade mark Register to ensure that the chosen trade mark is not identical or confusingly similar to a prior registration for the same or similar goods or services. Trade Mark searching is a highly skilled business and should be conducted by a specialised trade mark attorney.

### Classification of Goods and Services

An application to register a trade mark must specify the goods and services on which the Mark is used or proposed to be used. All goods and services fall into 45 categories or classes.

### Registration Procedures and Time Taken

#### Ireland

Within 2-3 months after filing, the application will be examined by the Patents Office to ensure that the mark is distinctive and not deceptive. The Patents Office will also carry out a search of the registers affecting Ireland to ensure the mark does not conflict with any prior application or registration. If such a problematic mark exists, it will be raised as an objection against registration of the mark and may be used as a basis to refuse registration of the mark.

If acceptable, the trade mark will be advertised in the Patents Office Journal so that other traders can have an opportunity to oppose. If no opposition is encountered the trade mark will proceed to registration and the Certificate of Registration will issue. The entire process can take as little as 9 months. A trade mark can be used prior to registration.

## UK

UK procedure differs somewhat from Irish procedure. While the application will be examined to ensure that the mark is distinctive and not descriptive, from 1<sup>st</sup> October 2007, the UKIPO (UK Intellectual Property Office) no longer refuse a Trade Mark Application based on the existence of a prior conflicting UK or Community Trade Mark application or registration. Nonetheless the UK Examiner will carry out a search and if any conflicting marks are identified, the Applicant will be notified and given the opportunity to either withdraw the Application, or to limit the goods and services covered by the same, in order to avoid the perceived conflict. Should the applicant fail to do so, the owners of the earlier right(s) will be notified of the application, thereby offering them the opportunity to oppose the application.

The UKIPO will automatically send notifications regarding the publication of potentially conflicting Trade Mark Applications to the owners of UK Trade Mark applications and registrations. However, the owners of CTM applications or registrations (which cover the UK) will not be automatically notified unless they specifically "opt-in" for each CTM. Opting in attracts a fee.

If acceptable, the trade mark will be advertised in the Trade Marks Journal so that other traders can have an opportunity to oppose. If no opposition is encountered the trade mark will proceed to registration and the Certificate of Registration will issue. The entire process can take as little as 5 months. A trade mark can be used prior to registration in the UK.

## European Trade Marks

The Community Trade Mark (CTM) system provides a single Registration giving uniform protection throughout the entire area of the [European Union](#).

The CTM Regulation provides an alternative to national trade mark filings in individual countries of the EU.

### Main points

1. Single registration – all countries of the EU.
2. Unitary character (all or nothing).
3. Availability to all natural and legal persons.
4. Multi-class applications.
5. Goods and/or services under International Classification.
6. OHIM languages – English, French, German, Spanish and Italian.
7. Substantive examination.
8. Opposition procedure based on prior CTM trade mark and/or national trade mark rights.
9. Right of conversion to national applications retaining date.
10. Duration – every ten years. One renewal.
11. Central recordal of assignments, licences, change of name, etc.
12. Extends to new member countries joining the EU in the future.
13. Retail service marks available.
14. Broad specifications including class headings.

### All or Nothing

It is not possible to hold a CTM registration excluding one or more EU countries. It is all or nothing. A single prior conflicting trade mark on the national register in one EU country can form the basis for opposition against the entire CTM application. If an opposition is successful, an applicant must abandon the application or alternatively may convert into a series of national applications and enjoy the same date of filing and priority or seniority of the CTM application.

## Who may Apply?

An applicant may be any natural or legal person (e.g. a company or association).

## What may be Registered?

A Community Trade Mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

This is a broad definition and although not specifically stated, could include slogans, sounds, smells and gestures. Registration can be in respect of goods and/or services.

## Languages

The OHIM official languages are English, French, German, Spanish and Italian. An Application for a CTM may be filed in any one of the twenty official EU languages. However, the applicant must indicate a second language which must be one of the five official languages of the OHIM. This second language may then be used as a possible language of opposition, revocation or invalidity proceedings.

## Please Note

While this guide has covered several topics, it is intended as a very basic introduction to trade marks, and certain procedures surrounding them, and as such, it is no substitute for consulting with a qualified trade mark attorney.

If you have any further questions please [contact us](#).

## © FRKelly

### **Dublin, 27 Clyde Road, Dublin 4, Ireland**

T:+353 1 231 4848  
F:+353 1 614 4756  
E: [dublin@frkelly.com](mailto:dublin@frkelly.com)

### **Belfast, 4 Mount Charles, Belfast BT7 1NZ, United Kingdom**

T:+44 28 9023 6000  
F:+44 28 9023 5454  
E: [belfast@frkelly.com](mailto:belfast@frkelly.com)